



R2001-294

SEP 5 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 31, 43 and 50 of the morning section and questions 7, 8, 15 and 49 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On January 26, 2001 petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under

35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the

answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional point for morning question 50. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning questions 31 and 43 and afternoon questions 7, 8, 15 and 49. Petitioner's arguments for these questions are addressed individually below.

Morning question 31 reads as follows:

31. Which of the following do not represent prior art?

- (A) The preamble of a Jepson claim.
- (B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.
- (C) A doctoral thesis indexed, cataloged and shelved in a university library.
- (D) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.
- (E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

The model answer is selection D.

See MPEP § 2128 under the subheading "Date of Availability," of the heading "Electronic Publications As Prior Art." (A) is wrong. See MPEP § 2129 under the heading "A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art." (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (C) is wrong. See MPEP § 2128.01 under the heading "A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public." (E) is wrong. See In re Nomiya, 184 USPQ 607, 610 (CCPA 1975); 35 U.S.C. § 102(d); MPEP § 2129 under the heading "Admissions By Applicant Constitute Prior Art."

Petitioner argues that answer (A) is correct. Petitioner contends that the model answer (D) comes from the AIPA provisions which were not to be tested and nevertheless does represent prior art because MPEP § 2128 states that a reference is a publication if it is available to the public, and that answer (A) does not represent prior art because a Jepson claim is only an implied admission of prior art.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the model answer (D) comes from the AIPA provisions which were not to be tested and nevertheless does represent prior art because MPEP § 2128 states that a reference is a publication if it is available to the public, and that answer (A) does not represent prior art because a Jepson claim is only an implied admission of prior art, petitioner's arguments are not conclusive for lack of evidence.

The AIPA does not contain any provisions as to the prior art status of internet data, and

the petitioner has not shown any provision in the AIPA that purports to do so. The question of whether an internet document is a publication is not at issue, but rather the question of sufficient evidence to show that such a document predated, i.e. was prior to the date of the claimed invention. Petitioner does not address the dates of publication which form the primary issue with selection (D). As to selection (A), the question does not ask which is not prior art but which does not represent prior art. An implied admission of prior art is a de facto representation of prior art. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 43 reads as follows:

43. Which of the following definitions does not accord with proper USPTO practice and procedure relating to drawings in patent applications?

- (A) Original drawings are drawings submitted with the application when filed, and may be either formal or informal.
- (B) Formal drawings are stamped "approved" by the Draftsperson.
- (C) Drawings may be informal for reasons such as the size of reference elements.
- (D) A substitute drawing is usually submitted to replace an original formal drawing.
- (E) A drawing may be declared as informal by the applicant when filed.

The model answer is selection D.

A substitute drawing is usually submitted to replace an original informal drawing, not an original formal drawing. MPEP § 608.02 under the heading "Definitions." (A), (B), (C), and (E) are wrong answers because they accord with the definitions set forth in MPEP § 608.02.

Petitioner argues that answer (B) is also correct. Petitioner contends that answer (D) is ambiguous and where interpreting (D) to mean changes are made upon an original formal drawing, then answer (B) is a better answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (D) is ambiguous and where interpreting

(D) to mean changes are made upon an original formal drawing, then answer (B) is a better answer, a substitute drawing is usually submitted to replace an original informal drawing, not an original formal drawing. MPEP § 608.02 under the heading “Definitions.” The instructions state “The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question.” Accordingly, model answer (D) is correct and petitioner’s answer (B) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 7 reads as follows:

7. Which of the following is true?

(A) Once an application is ready to be issued, there is a public policy that the patent will issue in regular course once the issue fee is timely paid. In accordance with the foregoing, issuance of a patent may not be deferred.

(B) The time period set for the payment of the issue fee is statutory and cannot be extended.

(C) While anyone may file a request for ex parte reexamination, a patent practitioner filing a request for ex parte reexamination must disclose the client’s name.

(D) It is necessary to claim priority under 35 U.S.C. § 120 to earlier filed applications for which a corresponding claim of priority has been made in the corresponding foreign filed applications of the same applicant.

(E) (A), (B), and (C).

The model answer is selection B.

See 35 U.S.C. § 151; MPEP § 1306. As to (A) see MPEP § 1306.01. As to (C) see MPEP § 2212. As to (D), the claim for priority is not required as a person may not wish to do so in order to increase the term of his or her patent. Since (A) and (C) are incorrect, (E) is incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that the answer (D) states what is needed to obtain priority and it is not unreasonable to assume that an applicant desires the earliest possible priority date.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the answer (D) states what is needed to obtain priority and it is not unreasonable to assume that an applicant desires the earliest possible priority date, the instructions specifically state "Do not assume any additional facts not presented in the questions." Applicants may wish to avoid a priority claim to extend the term of a patent. Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 8 reads as follows:

8. In early 1998, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1998. In August 1999, MC files a patent application in the United States for the reverse automobile heating system. In December 1999, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1998. Which of the following is true?

(A) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.

(B) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.

(C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.

(D) (B) and (C).

(E) None of the above.

The model answer is selection B.

In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (B) is true and (A) is not. (D) is incorrect since the people at MC were not the true inventors. (E) is incorrect inasmuch as (B) is correct.

Petitioner argues that answer (A) is correct. Petitioner contends that misappropriation cannot constitute an on sale bar as held in *Pennock v. Dialog* and *Shaw v. Cooper*, both Supreme Court decisions that have not been overturned.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that misappropriation cannot constitute an on sale bar as held in *Pennock v. Dialog* and *Shaw v. Cooper*, both Supreme Court decisions that have not been overturned, the court in *Evans Cooling Systems* distinguished those cases by "We, however, do not find any of these cases dispositive of the issue presented by this case. In *Pennock*, the Supreme Court actually invalidated the patents in suit under the public use bar, and in that case the use had been with the permission of the patentee, thereby rendering any statements regarding piracy mere dicta. Likewise, the statements relied on by Evans in *Shaw* are dicta, as there too the patent was invalidated because the innocent public had come to know and use the invention, although there was some evidence that the invention had first become known to the public by fraudulent means." *Evans Cooling System* applies to the facts presented in the question. Accordingly, model answer (B) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 15 reads as follows:

15. In December 1987, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inner core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 1999, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2000. Molly, after seeing the success of Troy's invention in the marketplace,

decides to file an application, also on February 1, 2000. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

(A) Since Molly invented the cutter before Troy, she is entitled to a patent and not Troy.

(B) Since Troy conceived of the idea after Molly and because Troy did not file a patent application before Molly, he is not entitled to priority over Molly.

(C) Since Molly disclosed the invention to Sue and Tom, the invention was known by others prior to the invention by Troy. Therefore, Troy is precluded by 35 U.S.C. § 102(a) from obtaining a patent on his idea.

(D) Since Molly effectively concealed her invention, Troy is entitled to a patent since although Molly conceived of the idea prior to Troy, she effectively abandoned the invention by not filing for twelve years.

(E) None of the above.

The model answer is selection D.

35 U.S.C. § 102(g) applies only when another inventor has not abandoned, suppressed or concealed the invention. In this case, Molly concealed the invention for 12 years. It was not until she saw the popularity of Troy's device that she filed a patent application. (A) is not true because Molly concealed the invention. (B) is not true since the invention of Molly was concealed for 12 years and effectively abandoned. (C) is not true since §102(a) applies only when the invention is publicly known by others. Since (D) is true, (E) is not.

Petitioner argues that answer (E) is correct. Petitioner contends that selection (D) is grammatically nonsensical and therefore, given that (A), (B) and (C) are also false, (E) is correct.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that selection (D) is grammatically nonsensical and therefore, given that (A), (B) and (C) are also false, (E) is correct, petitioner fails to show that the selection is nonsensical. It is clear that selection (D) states that Molly effectively abandoned the invention by not filing for twelve years. 35 U.S.C. § 102(g) applies only when another inventor has not abandoned, suppressed or concealed the invention. In this case, Molly concealed the invention for 12 years. It was not until she saw the popularity of Troy's device that she filed a patent application. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 49 reads as follows:

49. A complete continuation application by the same inventors as those named in the prior application may be filed under 35 U.S.C. § 111(a) using the procedures of 37 C.F.R. § 1.53(b) by providing:

(A) A copy of the prior application, including a copy of the signed declaration in the prior application, as amended.

(B) A new and proper specification (including one or more claims), any necessary drawings, a copy of the signed declaration as filed in the prior application (the new specification, claim(s), and drawings do not contain any subject matter that would have been new matter in the prior application), and all required fees.

(C) A new specification and drawings and a newly executed declaration. The new specification and drawings may contain any subject matter that would have been new matter in the prior application.

(D) A new specification and drawings, and all required fees.

(E) (A), (B), (C) and (D).

The model answer is selection B.

37 C.F.R. §§ 1.51(b), 1.53(b), and 1.63(d)(1)(iv); MPEP § 201.06(c), subsection styled "Specification and Drawings," 602.05(a). (A) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a copy of the prior application, including a copy of the signed declaration in the prior application, as filed. (C) is incorrect. As indicated by MPEP § 201.06(c), a continuation application may be filed under 35 U.S.C. § 111(a) by providing a new specification and drawings and a newly executed declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. (D) is incorrect. The oath or declaration is needed to name the same inventor in the continuation application. 37 C.F.R. § 1.53(b); MPEP § 201.06(c). (E) is incorrect because (A), (C) and (D) are incorrect.

Petitioner argues that answer (A) is correct. Petitioner contends that modification of an application is not only allowed but fundamental to the process filing a continuation.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that modification of an application is not only allowed but fundamental to the process filing a continuation, petitioner provides not support for the proposition that a complete continuation application by the same inventors as those named in the prior application may be filed under 35 U.S.C. § 111(a) using the procedures of 37 C.F.R. § 1.53(b) by providing a copy of the prior application as amended instead of a copy as filed, as specified in MPEP § 201.06(c). The two other possibilities listed in MPEP § 201.06(c) include a new rather than a copy of a prior specification. Accordingly, model answer (B) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy